



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,804	02/05/2004	Mark A. Wagner	29488/39975	5215
4743	7590	07/20/2006	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			MAGUIRE, LINDSAY M	
			ART UNIT	PAPER NUMBER
			3634	

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/772,804

Applicant(s)

WAGNER ET AL.

Examiner

Lindsay M. Maguire

Art Unit

3634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Non-Final Office action is in response to the application filed on February 5, 2004, and the response to the Restriction/Election requirement filed on May 2, 2006.

Election/Restrictions

Applicant's election with traverse of Group I and Species (a) in the reply filed on May 2, 2006 is acknowledged. The traversal is on the ground(s) that there would not be a serious burden on the Examiner because all of the inventions are directed towards a store lead-in fixture for a product dump table.

This is not found persuasive because at the outset, it appears from applicant's arguments that applicant has not analyzed the examiner's action in the context of the established practice for requiring a provisional election of species as established in Chapter 800 of the MPEP. It is a well-established practice that a requirement to elect a single disclosed species is a holding by the examiner that the plural species, as claimed, are patentably distinct, i.e., capable of supporting separate patents. See MPEP 808.01(a) and MPEP 809.02(a). If the applicant is of a different view, then applicant need merely clearly state on the record that the species are not patentably distinct. Neither the examiner nor the applicant needs to present any reasoning. Of course, it should be noted that the species that are not patentably distinct for restriction purposes are also not patentably distinct (i.e., obvious in view of one another) for rejection purposes. Applicant's response implies that the various identified species are

not considered to be patentably distinct. If such is the case, then applicant must clearly admit this on the record or point to evidence already of record.

With respect to applicant's argument, it is noted that the examiner fully complied with the required and well-established procedures pertaining to the making of a provisional election requirement. The procedures are clearly and explicitly outlined in MPEP 809.02(a). Further, MPEP 817 clearly states that "(t)he statement in MPEP § 809.02- § 809.02(d) is adequate indication of the form of letter when an election of species is required." Further, MPEP 806.04(h) clearly states that the examiner is to group together species that are clearly unpatentable over each other. Thus, it is inherently quite evident that species **not** grouped together are considered to be patentably distinct from the other separately listed species.

Further, the implication that applicant is otherwise unable to ascertain the basis for the grouping of species, i.e., why they are patentably distinct from each other is not well taken. In particular, applicant's attention is directed to the instant specification wherein several "embodiments" are each specifically and individually disclosed and described with respect to the features thereof. Accordingly, it is quite evident from this disclosure, as well as perusal of the respective figures of each species grouping alone or in combination with the written description, that the reason the embodiments are considered to be patentably distinct is that each embodiment encompassed a separate invention.

With respect to the above and applicant's response, it is noted that applicant has failed to point out why each, or any, of these identified species are not patentably distinct.

Furthermore, it is noted that applicant's own response clearly evidences the presence of claims reciting mutually exclusive characteristics and thus is fully supportive of the examiner's action of requiring an election of species. In particular, by applicant's own hand, the claims "mutually excluded" from the elected species have been clearly identified. Nevertheless, it appears that applicant has taken the first sentence of MPEP 806.04(f) out of context with the implication that some particular requirement of action is being imposed on the examiner that must be conveyed to applicant in an election of species letter before an election of species requirement can be considered proper. However, continued reading of MPEP 806.04(f) does not bear this out and neither MPEP 806.04(h), MPEP 808.01(a), MPEP 809.02(a), nor MPEP 817 indicate that the "general test" indicated by MPEP 806.04(f) is nothing more than a mental exercise on the part of the examiner in determining whether or not to proceed with an election of species requirement.

Still furthermore, it is noted that applicant has (1) failed to show that a coextensive search is a reason for not requiring an election requirement and (2) failed to establish that a coextensive search is present. Yet still furthermore, applicant has failed

to show that a search is the overriding criteria in determining the burden imposed upon the examiner.

Applicant's general allegation that "search and examination of the entire application would not place a serious burden on the Examiner" fails to comply with the requirement of 37 CFR 1.111 and is wholly insufficient. In particular, what is the basis relied upon to arrive at the conclusion that no serious burden is imposed? Is applicant alleging that the examiner would only have to consider the patentability of the generic aspects of the invention? Is applicant asserting that the numerous species are not patentably distinct and thus are obvious in view of one another? Is applicant asserting that all claims stand or fall with the patentability determination of claim 1 and thus separate arguments directed toward each individual species would not have to be considered? Nevertheless, it is extremely burdensome to have to carry out an examination, including consideration of and response to arguments, for all of the specific features of each of the multiple patentably distinct species in the same application when no patentable generic claim is indicated to be present.

Finally, applicant should note with respect to species and an election of species requirement in general that there are two and only two alternatives available and each alternative is an absolute and is mutually exclusive of the other. In particular, species can *only* be either (1) patentably distinct or (2) not patentably distinct. There is no middle ground between these two choices. If the species are patentably distinct, they

Art Unit: 3634

are restrictable. If the species are not patentably distinct, then they are not restrictable. The examiner, in accordance with well-established practice and procedure, has clearly indicated a position that the various species, are patentably distinct. Applicant's response appears to take issue with this position and thus appears to be taking the opposite position that the various species are not patentably distinct. In other words, if applicant objects to the examiner's holding that the species are patentably distinct, then it inherently follows that applicant is asserting that the species are not patentably distinct because that is the only alternative left. If this is correct, then applicant should clearly admit on the record that the various identified species are not patentably distinct. If this is not a correct interpretation of applicant's response, then applicant should clearly explain what the interpretation should be.

The provisional election requirement is still deemed to be proper and remains in effect.

The requirement is still deemed proper and is therefore made FINAL.

In conclusion, the following claims read on Group I, Species (a): Claims 1-9. Accordingly, claims 10-20 have been withdrawn from further prosecution. It is further noted that claim 10 has been withdrawn from further consideration as it is drawn to the non-elected species (b) for containing the following elements, a pegboard surface and at least one product hanging projection mounted to the pegboard surface, which are only present in the non-elected species (b).

Drawings

The drawings are objected to under 37 CFR 1.83(b) because they are incomplete. 37 CFR 1.83(b) reads as follows:

When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specifically, it is not readily apparent to one of ordinary skill in the art the specific differences between reference numbers "20", "28a", "20a", and "32". While the

specification does set forth a different element for each of the aforementioned reference numbers, Figure 2 does not provide adequate detail to be able to determine the exact distinctions of each individual reference number.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the sleeve, element "32" in claims 6 and 7 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. It is noted that reference number "32" is present in Figure 2, however there is not enough detail in the Figure so that one of ordinary skill in the art would be able to ascertain what exactly is being referenced (see the detailed objection of Incomplete drawings above for a broader explanation).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

Art Unit: 3634

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Abstract

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. Additionally, the word "comprise" should also be avoided.

Claim Objections

Claim 4 is objected to because of the following informalities: the phrase "associated the top ends" in line 3 is considered grammatically incorrect. The word --with-- is missing between "associated" and "the". In order to expedite prosecution the claim has been examined as such. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not readily apparent to the Examiner if the Applicant is claiming a Store Lead-in Fixture alone, or in combination with a Product Dump Table having a sidewall terminating in a top edge adjacent a product-receiving cavity. Specifically the application positively recites a sidewall terminating in a top edge adjacent a product-receiving cavity throughout the claims. If the applicant intends on claiming the combination then the applicant should clearly and positively recite the combination in the preamble. In the interest of compact prosecution, the recitation "for a product dump table...receiving cavity" in lines 1-2, has been regarded as an intended use recitation, and therefore only the elements related specifically to a store lead-in fixture have been examined.

Claim 1 recites the limitation "the side wall" in line 4 and "the top edge" in line 6. There is insufficient antecedent basis for these limitations in the claim, since the claimed element of "the product dump table" has not been positively set forth in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5, 6, 8, and 9 are rejected under 35 U.S.C. 102(e), inasmuch as the claims can best be understood in view of the section 112 rejections (as advanced above), as being anticipated by U.S. Pat. No. 6,540,093 (Shumway '093).

Shumway '093 discloses a support structure (10) comprising a pair of generally vertical frame members (12) disposed in spaced relation; a mounting structure (30) comprising at least one hanger (30) integrally associated with the support structure (Figure 1), which comprises a sleeve (34); and a presentation structure (60, 68), that includes at least one product display shelf (68), and extends between and is operatively

Art Unit: 3634

associated with a pair of spaced generally vertical frame members of the support structure.

It is noted that although Shumway '093 shows "Window Shelf System", Shumway '093 is considered to be able to function as a "Store lead-in fixture for a product dump table" as called for in the instant claims. Further, the recitations "for a product dump table...cavity" in lines 1-3 of claim 1, "to be placed in confronting relation...table" in lines 4-5 of claim 1, "to be placed in operative association...table" in lines 6-7 of claim 1, "to be placed in contact with...table" in line 3 of claim 2, etc. are intended use recitations (It is noted that these are merely a few of the intended use recitations that are within the claims. It is recommended that applicant carefully review each claim for further instances of intended use). While Shumway '093 does not explicitly show the apparatus in these configurations, a reference needs only be capable of being in these configurations in order to "read on" the claim language. In this case, the "Window shelf system" could be attached to a product dump table for increased versatility and usefulness of the apparatus.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, and 7 are further rejected under 35 U.S.C. 103(a), inasmuch as the claims can best be understood in view of the section 112 rejections (as advanced above), as being unpatentable over Shumway '093.

Shumway '093 discloses the device substantially as claimed, as advanced above, with the exception of requiring: (a) that the support structure further includes a generally horizontal frame member extending between and being integrally associated with each of the spaced generally vertical frame members (claims 3, lines 1-3; (b) each of the generally vertical frame members has a top end and a bottom end and the generally horizontal frame member extends between and is integrally associated with the top ends (claim 4, lines 1-3); and (c) the sleeve is integrally associated with a generally horizontal frame member extending between and integrally associated with a pair of generally vertical frame members (claim 7, lines 1-3).

With respect to (a) – (c), Shumway '093 discloses a pair of generally vertical frame members (12), each having a top and bottom, and a sleeve member (34); it would have been obvious to one of ordinary skill in the art at the time the invention was made, (i.e. the examiner is taking official notice), to include a generally horizontal frame member extending between and being integrally associated with each of the generally vertical frame members for such a basic reason as to increase the overall strength and stability of the device.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lindsay M. Maguire whose telephone number is 571-272-6039. The examiner can normally be reached on M-F: 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lindsay M. Maguire
7/14/06


Jerry Redman
Primary Examiner